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IN THE

Supreme Court of the United States

OCTOBER TERM, 1946.

No. 700

BORG-WARNER CORPORATION and
DAVID E. GAMBLE,

Petitioners,

vs.

GEORGE I. GOODWIN and JOHN F. DAUKUS,
Respondents.

PETITION FOR REHEARING.

MAX W. ZABEL,
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BENTON BAKER,
Counsel for Petitioners.

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OPINION OF THE COURT BELOW

Goodwin v. Borg-Warner Corp., 157 F (2) 267

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OCTOBER TERM, A. D. 1946.

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PETITION FOR REHEARING.

To the Honorable Frederick M. Vinson, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your petitioners respectfully request that the Court reconsider its action of January 6, 1947, denying petition for writ of certiorari filed in the above entitled case November 22, 1946; that the order then entered in this case be vacated; and that a writ of certiorari to the United States Court of Appeals for the Sixth Circuit be granted according to the prayer of said petition.

The discretionary power of this Court is invoked, under established precedent upon the following grounds:

1. The Court of Appeals for the Sixth Circuit has sustained as valid a patent which dominates a substantial part of the automobile industry, at least 95% of which industry is concentrated within the jurisdiction of the Sixth Circuit whereby, litigation, with a resulting conflict of decision, is highly improbable.
2. The Court of Appeals for the Sixth Circuit, in a decision *reversing* the District Court, has sustained as valid a patent for an alleged combination which is unpatentable over the prior art and is plainly aggregational on its face, which decision is in direct conflict with recent pronouncements of this Court.
3. That since the filing of said petition petitioners have become advised that the patent in suit has been rendered invalid in its entirety because respondents have deliberately and unreasonably neglected or delayed to enter a disclaimer of invalid claims of that patent in violation of the disclaimer statutes (Sections 4917, 4922 R. S., U. S. C. Tit. 35, Secs. 65, 71), thereby invalidating the entire patent.

Point I.

Respondents By Virtue Of The Judgment Of Which Review Is Sought Are In A Position To Dominate Substantially The Entire Automobile Industry Without Litigating The Patent In Suit Beyond The Sixth Circuit.

This Court since the case of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 79 L. Ed. 997, 55 S. Ct. 449, has uniformly granted certiorari in *all cases* where a patent has been *sustained* in a circuit wherein the industry is so concentrated that litigation elsewhere, with a resulting conflict of decision, was improbable.

Respondent's brief in opposition to the original petition recites only cases of refusal to grant certiorari where the patent has been declared *invalid* and wherein, therefore, no question of public interest, necessitating prompt decision by this Court, was involved.

This Court has definitely ruled in connection with an invention relating to *pistons*, that the automotive industry is so concentrated in the Sixth Circuit that litigation elsewhere is unlikely. See *Schriber-Schroth Company v. Cleveland Trust Company*, 305 U. S. 47, 83 L. Ed. 34 (decided November 7, 1938), where the Court said (p. 50):

"We later granted certiorari in 304 U. S. 587, 82 L. Ed. 1548, 58 S. Ct. 1052, 1053, on a petition for rehearing showing that, notwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit. Cf. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 79 L. Ed. 997, 55 S. Ct. 449; *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005, 55 S. Ct. 455."

Certiorari in that case was granted contrary to the assertions in respondent's brief in opposition to the original petition (last paragraph, page 4), *solely* because of the concentration of the automotive industry and not because of any "new question of patent law".

Petitioner in the *Schriber-Schroth* case established concentration of approximately 95% of the industry by quoting from a recognized trade paper, "Automotive Industry" dated February 26, 1938, showing sales of automobiles by the various manufacturers in the period from 1929 to 1937 which were condensed, as follows, together with an affidavit establishing that 95% of the pistons made in the United States were either manufactured in the States of Ohio and Michigan or assembled into automobiles by manufacturers located within the States of Ohio and Michigan:

<i>Manufacturers Within the Sixth Circuit</i>	<i>Manufacturers Without the Sixth Circuit</i>	
General Motors .. 8,787,556	Auburn	94,783
Chrysler 4,170,813	Austin	12,045
Ford 6,399,757	De Vaux	6,166
Continental 4,263	Durant	77,519
Graham 192,077	Franklin	25,585
Hudson 810,155	Marmon	41,830
Hupmobile 119,563	Nash	399,535
Packard 317,563	Studebaker	482,941
Reo 54,018	Miscl.	58,542
Willys 439,026		
Total 21,294,814	Total	1,198,946

Petitioners presented in their petition for writ of certiorari (p. 34) a summary of data from "Automotive and Aviation Industry" of March 15, 1945, showing even a greater concentration of the automobile industry in the Sixth Circuit as affecting this case.

Supplementing the matters previously presented by petitioners on this point affidavits¹ of responsible, informed persons are presented herewith which show that the accused Borglite plate is standard equipment in twelve of the leading makes of automobiles and is manufactured by General Motors Corporation in quantities of several hundred thousand as well as by Borg-Warner, thus making the judgment in this case effective against a large part of the automobile industry. These affidavits also show not only that more than ninety-five percent of the factory sales of all automobiles sold in the United States are made by companies having an established place of business in the States of Michigan and Ohio where they manufacture or sell motor vehicles within the Sixth Circuit, but that more than ninety-five per cent of the driven clutch plates manufactured in the United States for assembly in automobiles in the United States are either manufactured by manufacturers located within the States of Michigan and Ohio, or manufactured by the said Borg-Warner Corporation (which will be bound by the judgment entered in this case), or assembled in automobile engine assemblies in the States of Michigan and Ohio. It is thus apparent that under Sec. 48, Jud. Code, U. S. C. Tit. 28, sec. 109; Sec. 4884, R. S., U. S. C. Tit. 35, sec. 40, the respondents need not go beyond the Sixth Circuit to dominate substantially

¹These affidavits are set forth in the Appendix to this petition (infra pp. 27-34) and include statements under oath by Oscar P. Pearson, Statistician of the Automobile Manufacturers Association, which not only receives regular reports from its members but statistical data of factory sales by the entire automobile industry; by Tolbert L. Knecht, vice-president and general manager of Borg and Beck Division of Borg-Warner Corporation; and by the president of the Automotive Division of the Chilton Company, which publishes the publications cited in the briefs of both parties.

the entire automobile industry under the judgment of the Court of Appeals of which review is sought.

The respondents' showing in their brief in opposition to the petition for writ of certiorari wholly fails to overcome petitioners' showing. Practically all companies listed by respondents as beyond the Sixth Circuit are minor manufacturers whose production is practically negligible, as the statistics which have been cited show. Respondents' showing as to the manufacture of clutch plates for replacement purposes is beside the point, for there would be no replacements but for the original assembly and sale within the Sixth Circuit and the elimination of a given type of clutch plate as original equipment would eliminate the replacement of it. A similar contention was made in the *Schriber-Schroth* case, but it was there pointed out by the petitioner that the few non-resident manufacturers of automobiles could in effect be subjected to the jurisdiction of the courts of the Sixth Circuit by suits against dealers, as indeed they have in the past (*Reeke-Nash Motors v. Swann*, 88 F. (2) 876; *Gear Grinding Company v. Studebaker Corp.*, 270 Fed. 934).

The invention involved in the *Schriber-Schroth* case related to pistons while the invention here relates to clutch plates. The *piston* of the type involved in the *Schriber-Schroth* case and the *clutch plate* of this case are *component parts* of an automobile engine assembly. There, as here, the respondents argued that the concentration of the automobile industry in the Sixth Circuit was unimportant as many pistons were made by companies non-resident to the Sixth Circuit, or were manufactured for replacements elsewhere. This Court nevertheless granted certiorari upon petitioner's showing that a large proportion of such pistons were either made within the Sixth Circuit or *assembled* into automobiles by manufacturers located within the States of Ohio and Michigan (p. 9, Petitioner's *Second Petition for Rehearing*). Regardless of the Circuit where-

in manufacturers of clutch plates may be resident, here, as was established in the *Schriber-Schroth* case, at least 95% of the automobile industry *using such clutch plates* is concentrated within the Sixth Circuit. Four of the clutch manufacturers tabulated on page 12 of respondents' brief are subsidiaries of petitioner. Accordingly that circuit possesses nation-wide jurisdiction of the patent in suit by proceedings which may be instituted against the *sellers or users* of automobiles into which such clutches are assembled.

Respondents themselves being inhabitants of the Sixth Circuit, no member of the public can obtain an adjudication of the patent in another circuit by Declaratory Judgment proceedings or otherwise.

In such a situation it is evident that this Court will never have an opportunity to resolve a conflict between decisions of the different Circuit Courts of Appeal. It is unreasonable to expect that respondents will risk their 95% control of the automobile industry in any effort to dispose of the other 5% by placing the patent in jeopardy in another circuit. The decision, unless reversed, therefore has nationwide finality; the practical effect, indeed, of a decision by this Court.

In *Exhibit Supply Company v. Ace Patents Corporation*, 315 U. S. 126, 86 L. ed. 737, the Court granted certiorari on rehearing without a conflict of decision, saying (p. 128):

"Although there is no conflict of decision, we were moved to grant the petition by the nature of the questions presented, together with a showing that the industry affected by the patent is located in the seventh circuit so that litigation in other circuits resulting in a conflict of decision would not be likely to occur."

Again, in *Muncie Gear Works, Inc., v. Outboard, Marine & Manufacturing Company*, 315 U. S. 759, 86 L. Ed. 1171, the Court, following the *Schriber-Schroth* and the *Paramount* cases, granted certiorari because of the concentration of the industry and the improbability of litigation elsewhere (pp. 765, 766):

"While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. 314 U. S. 594, *ante*, 479, 62 S. Ct. 100. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, 83 L. Ed. 34, 59 S. Ct. 8."

The same considerations would seem to call for like action in this case.

Point II.

The Court Of Appeals For The Sixth Circuit, By Reversing The Judgment Of The District Court, Has Erroneously Validated Alleged Combination Claims Which Are Plainly Invalid As Defining An Unpatentable Aggregation Of Old And Well-Known Elements In Direct Conflict With Applicable Decisions Of This Court.

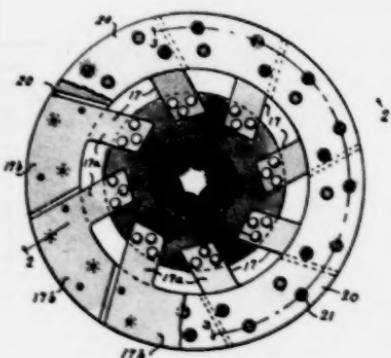
The District Court (Judge Lederle) following a three day argument, in exhaustive Findings of Fact and Conclusions of Law (R. 35), ruled that *all* of the claims of the Daukus patent in suit were invalid.

In Fact Finding 10 (R. 36, 37) the District Court quoted from an opinion of the Board of Interference Examiners to the effect that the *only* feature regarded by the Patent Office as giving vitality to the Daukus claim was to make cushion members 31 of thinner material than the interme-

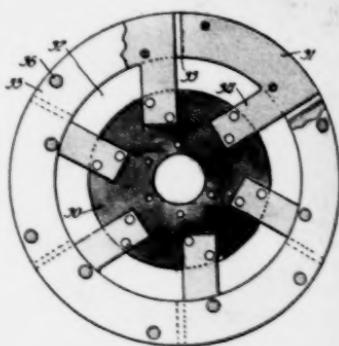
diate disk 30 to which they are attached.³ The Board was then referring to interference counts 4, 5, 6, 7, 9 and 10, which corresponded to Daukus claims 13, 14, 15, 17, 19 and 20, sustained by the Court of Appeals. The decision of the Board fixed the scope of the alleged invention in controversy in relation to the prior art considered by the Patent Office. It remained unchallenged by Daukus. Accordingly, each of the twenty-three claims of the patent in suit necessarily was required to be limited to the feature of the relative thickness of the cushion elements and the intermediate member.

"A distinguishing feature of the new clutch plate is that the cushion members are of thinner material than is an intermediate member on which they are mounted; that is, the cushion members are of less weight per unit area than the disk-like intermediate member, thus reducing the spinning inertia of the clutch plate, and permitting quick shifting of the gears which is the ultimate object of the invention of the counts. * * * Perhaps the closest prior art is illustrated in Figure 4 of the Daukus patent, No. 1,777,399 which figure shows elements corresponding to those of the new friction plate, except that it does not explain whether the outer L-shaped cushion members 31 are thinner or thicker than the intermediate disk 30, or are of the same thickness. Because of this indefiniteness, the counts cannot properly be said to express only a difference in degree over what is shown in the patent."

The decision of the Board of Interference Examiners will be more fully understood by comparing Fig. 1 of the Daukus patent in suit (R. 408) with Fig. 4 of the Daukus prior art patent (R. 208) here reproduced:



DAUKUS PATENT
IN SUIT
No. 2,324,913
FIG. 1 (R. 408)

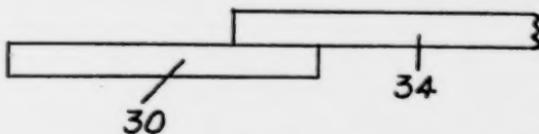


PRIOR ART
DAUKUS PATENT
No. 1,777,399
FIG. 4 (R. 208)

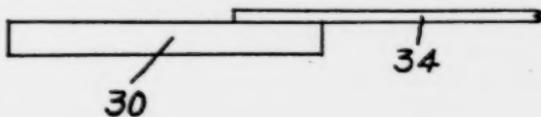
Corresponding parts are colored alike, though numbered differently. Friction facings (yellow) are partially broken away to show peripheral portions of cushion members (blue). The structural arrangements differ only in the number of rivets and holes provided therefore, a slightly different angular arrangement of cushion members (blue) respectively designated 34 and 17, an increased number of them in the case of the patent in suit, and the omission from the drawing of the earlier patent of the hub and associated parts including flange (brown) and rivets (green), shown in the drawings of the patent in suit and essential to and contemplated in the structure of the earlier patent.

Considering the intermediate member 30 and an L-shaped cushion member 34, 31 of the prior art patent as viewed edgewise, that is, looking along the plane of the drawing toward an edge of the clutch plate,

^{The} The Board reasoned that, because the prior art Daukus patent did not show the relative thicknesses of elements 30 and 34, it was *assumed* that they were of the same thickness, thus (viewing the intermediate member 30 and an L-shaped cushion member 34, 31, as if turned edgewise),



Accordingly it was held by the Board to be invention to make element 34 thinner than element 30, solely to reduce its weight and so its spinning inertia, thus,



This was the *only* feature held to be novel by the Patent Office.

At the trial petitioners produced evidence with which the Patent Office was unfamiliar when granting the claims and of which the rules of the Patent Office did not permit consideration. See *Stern v. Schroeder*, (C. C. P. A.), 36 F. (2) 518, 521. That evidence clearly established that cushion members of thinner material than the intermedi-

ate disk were indeed old long prior to Daukus' advent (Fact Finding 11, last sentence, R. 38).³

The *prima facie* force of the Daukus patent is thus destroyed, as the only consideration for its grant has now been proven to be old.

The District Court (R. 37, F. F. 11) held that making the cushion members thinner than the intermediate plate did not involve invention (thus nullifying the *only* feature of novelty, as found by the expert tribunals of the Patent Office) regardless of the proven public use.

Respondents were forced to concede the correctness of that fact (Appendix pp. 34, 35).⁴

““However, the record in this case proves *beyond a reasonable doubt* that it had been a common practice more than two years prior to the alleged invention to make the cushion elements of steel and thinner than the intermediate member.” (Emphasis ours.)

“I say this, that our claims which do not bring in the fact that our cushion members are both distorted axially and are structurally independent members between the facings, if the claims do not bring that in, I do not believe they define invention . . .”.

(Quotation of statement by Mr. Griest appearing on pp. 81, 82 of transcript of proceedings in this cause before District Judge Lederle at Detroit, Michigan, on September 26, 1944. Appendix, p. 35).

Respondents at the trial accordingly restricted their counterclaim by the elimination of many claims of which claim 1 is an example.⁵

Respondents were thus forced, in view of the evidence adduced at the trial, to rely for patentable novelty upon the mere thought of waving or axially distorting structurally independent members whereby to keep the attached friction facings separated, a feature the Patent Office had obviously (and necessarily as will appear) not regarded as importing patentability to the interference counts. In this connection will the Court kindly re-examine the "Borg-Warner prior commercial practice under the Reed patent compared with Daukus' Exhibits 2 and 5" and "Chart of Development of Borglite Plate" attached to petitioners' brief in support of petition for writ of certiorari (opposite page 22 and at end of the brief, respectively).

The District Court in fact finding 11 (R. 37) held that

"Assuming that it could be said that the discovery that the 'L-shaped' cushion members of lighter materials would reduce the spinning inertia of the plate constituted patentable invention, the invention was not made by Daukus. Clutch plates embodying this concept were in use and on sale prior to 1930. The *evidence of this prior use was not before the Patent Office.*" (Emphasis ours.)

⁵Claim 1. "In a clutch plate construction, a hub, an intermediate member non-integral with said hub and secured thereto, a cushion member of thinner material than said intermediate member and carried thereby, said cushion member extending outwardly from said intermediate member and at its outer portion subtending a greater arcuate angle than is subtended by a portion of said cushion member between said intermediate member and said outer portion of said cushion member."

Notwithstanding the admissions of Daukus' counsel at the trial (Appendix pp. 34, 35) some of the sustained claims completely fail, in fact, to narrow the invention to the axial distortion or waving or bowing of the cushion elements. Thus claims 4 and 17 read *verbatim* upon the Daukus earlier patent 1,777,399, a statutory bar to the Daukus patent in suit, with the *sole* exception that said earlier Daukus patent does not clearly describe the now proven old feature of making the cushion elements 34, 31 of thinner material than the intermediate member 30. The effect of the decision of the Court of Appeals, therefore, unless reversed, would render it unlawful for any member of the public to manufacture the precise structure shown in this prior art patent issued to Daukus in 1930 (Figure 4, opposite page 3 of petition for writ of certiorari) provid-

*Claim 4. "In a clutch plate construction, a central hub, an intermediate member, a plurality of angularly formed sections of *less thickness* than said intermediate member and provided with necks overlying and secured to said intermediate member, the unsupported ends of said sections being materially wider than said necks and co-operating with each other to form a relatively continuous ring spaced outwardly from said intermediate member, and friction material secured to said cooperating sections."

Claim 17. "In a friction clutch plate, a hub, a mounting disc mounted on said hub, comprising a substantially circular central disc portion of sheet metal of such thickness as to be substantially unyielding and to adequately withstand the torque loads imposed upon it during clutch operation, and a peripheral region having a low rotational inertia, said peripheral region comprising a plurality of yieldable cushion members of materially lesser thickness and weight per unit area than said disc portion spaced from the periphery of said disc portion, neck members of reduced circumferential width compared to that of said cushion members, joining said cushion members to the disc portion, and friction facings embracing and secured to opposite sides of said cushion members."

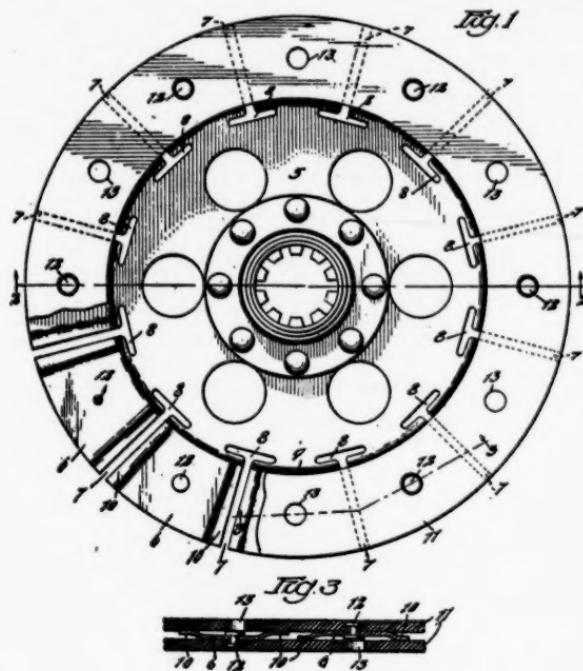
ing such cushion elements are attached to an intermediate member or connecting web having greater thickness than the cushion elements. *Indeed, if the patent in suit is upheld, Borg-Warner would be enjoined from making the Ahlene plate of which it sold millions beginning in 1931.* Such a situation is contrary to the fundamental rule of patent law, conceded by respondents' counsel, that

“Anything that would, coming later, be an infringement, would, if it came before, be an anticipation. And I agree with that 100% .” (Appendix p. 34)

This early Daukus patent itself contains a clear disclosure of the axial distortion of the cushion elements for imparting yieldable engagement of the friction facings with the friction plates.⁷

“The segments may be bent laterally at the slots 33 in the manner described in connection with Figures 2 and 3, if desired.” (Page 2, col. 1, lines 53-55; See also, page 2, col. 1, lines 1-14, R. 208.)

The opinion of the Court of Appeals seems to rely on the fact (obviously unpatentable as declared by the Patent Office in its ruling) that the peripheral portions 17b of the patent in suit are bowed in a more pronounced manner than in the prior Daukus patent, but that feature is the invention of Mr. Gamble in his patent No. 1,659,289 of 1928 (R. 386) shown below:



There were countless varieties of such peripherally, i. e., circumferentially, bowed cushion elements in use long prior to Daukus.

Petitioners' evidence introduced at the trial as supplemental to the Patent Office record, established that it was common practice to employ the waving or distortion feature for exactly the same function in the Borg-Warner commercial structure beginning in 1931 (R. 137 XQQ 83-88 Plaintiffs' Exhibits AAA 21,-23). These structures are clearly illustrated in the charts attached to the original petition for a writ of certiorari. Whether or not the cushion elements are all part of one plate, i. e., "integral type", or are wholly separate and independent, was conceded by Daukus, himself (pp. 25, 60, 61, 80 and 136, Pl. Ex. AAA 1), in the interference proceedings, to be functionally unimportant:

"Those webs don't mean nothing only better to assemble clutch plate."*

Furthermore the claims in suit fail completely to define a valid combination and are clearly invalid as unpatentable aggregations. Thus the axial distortion of the cushion elements for imparting yieldable engagement to the friction facings (as first shown in Gamble patent No. 1,659,289, R. 386) performs a function wholly independent of whether (a) the cushion elements are of thinner material than the connecting web; or (b) whether the cushion members are integrated or structurally independent. The function of making the cushion members of lighter material, to reduce inertia, has utterly no co-action with the waving or distortion thereof.

No new element has been invented by Daukus; the claims at best simply contain recitations aggregating old and well known features of the prior art. No new result oc-

*See notations on chart attached to original petition (opp. p. 22) "Borg-Warner commercial practice under Reed patent compared with Daukus' Exhibits 2 and 5."

cers. This Court has accordingly ruled that such patents are void. *Powers Kennedy Corp. v. Concrete M. & C. Co.*, 282 U. S. 175, 186, 75 L. Ed. 278, 286:

"For these reasons we find that the patent (for a concrete conveyer using compressed air) is invalid. It consists of a combination of elements all of which were old in the art. Its application to the transportation of concrete did not involve invention. Neither the combination of old elements or devices accomplishing no more than an aggregate of old results (citing cases), nor the use of an old apparatus or appliance for a new purpose (citing case) is invention."

Further authority by this Court will be found in:

Keystone Driller Co. v. Northwest E. Corp., 294 U. S. 42, 50, 79 L. Ed. 747, 752.

Grinnell Washing Mach. Co. v. E. E. Johnson, 247 U. S. 426, 432, 62 L. Ed. 1196, 1199.

Pickering v. McCullough, 104 U. S. 318.

This Court as recently as October 18, 1946, ruled, on re-hearing, in *Halliburton Oil Well Cementing Company, Petitioner, v. Clifford P. Walker, Respondent*, that combination claims and improvements or additions to them must be viewed with *very close scrutiny*.

In *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, the Court said (p. 90):

"Since *Hotchkiss v. Greenwood*, 11 How. (U. S.) 248, 267, 13 L. Ed. 683, 691, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art."

As this Court stated in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 (at page 549):

"As we said of Gullborg in the Rogers Case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other

old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."

Obviously the Court of Appeals was unduly influenced by the circumstance that Borg-Warner Company had, itself, attempted to secure a patent on the clutch plate in issue. That apparent inconsistency was referred to in Fact Finding 9 (R. 36) but as pointed out by the District Court in Fact Finding 11 (R. 37) the evidence produced by the petitioners *was not before the Patent Office*. It was unknown to Petitioners' patent attorney when prosecuting the Gamble application. The bill of complaint in the declaratory judgment suit was based on the contention that all claims, including the interference counts were invalid, thus disclaiming any right in Borg-Warner to the claims hereof unless limited to the special material used in the Borglite plate, namely, clock spring steel. This contention Borg-Warner could consistently then make because of the proven public use.

In any event this Court has expressly ruled that the public interest in such cases is paramount and that the loser of an interference contest is not estopped to dispute the validity of a patent on subject matter it had once asserted. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464. The public interest in patent litigation was again expressed by this Court in *Muncie Gear*

Works, Inc. v. Outboard, Marine & Manufacturing Company, 315 U. S. 759, 769:

“*** * To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes, and so frequently present but so seldom adequately represented in patent litigation.”

And in *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U. S. 661, speaking through Mr. Justice Douglas the Court said (p. 665):

“It is the public interest which is dominant in the patent system.”

The decision of the Court of Appeals on rehearing (R. 485) incorrectly intimates that the Daukus early patent 1,777,399 was lightly regarded by petitioners, as petitioners introduced no testimony relative to that patent during the trial. Indeed, that court rather baldly concluded:

“In view of the absence of testimony supporting appellees' contention that Daukus Patent No. 1,777,399 invalidates Daukus Patent No. 2,324,913, the conclusions of the expert tribunals should not lightly be set aside.”

That Court obviously overlooked the fact that respondents had maneuvered petitioners to file a bill in equity under Sec. 4915 R. S., in the Sixth Circuit, where petitioners were resident, by the notice of election served under Sec. 4911 R. S., U. S. C. Tit. 35, Sec. 59 (a) after petitioners had given notice under Sec. 4912 R. S., U. S. C. Tit. 35, Sec. 20, of their appeal to the Court of Customs and Patent Appeals, and that in such proceedings under Sec. 4915 R. S. the record in the Patent Office is admitted with the same force and effect as if originally taken and produced in the suit.

Indeed, Sec. 4915 R. S. expressly provides:

"In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such term; and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

Petitioners therefore introduced the record with the Opinion of the Board of Interference Examiners relative to the disclosure of the Daukus patent (Fact Finding 10 R. 36) (what better expert testimony could have been offered?) and proceeded to take *additional* testimony to establish that it was common commercial practice to make the connecting web thicker than the cushion elements, which was the *only* feature relied upon by the Patent Office Board of Interference Examiners as lending patentability to the Daukus claims.

Respondents took no testimony before the District Court to establish the incorrectness of said ruling of the Board of Interference Examiners. If Daukus had considered himself to be entitled to a broader scope of invention he could have proposed ^{to the Patent Office} other claims accordingly and obtained a ruling thereon but did not. The burden was plainly upon him to do so.

Point III.

Respondents Have Deliberately And Unreasonably Neglected Or Delayed To Enter A Disclaimer Of Invalid Claims Of The Patent In Suit In Violation Of The Disclaimer Statutes, Thereby Invalidating The Entire Patent.

On September 26, 1944, respondents' counsel, in view of the evidence produced by petitioners, admitted the invalidity of the broader claims of the patent in suit and recognized the necessity of filing a statutory disclaimer under the disclaimer statutes (Sections 4917, 4922 R. S., U. S. C. Tit. 35, Secs. 65, 71). See Appendix, *infra*, pp. 34, 35.

At the hearing of the cause before the District Court on June 1, 1944, respondents restricted their counterclaim, charging infringement, to claims 4, 6, 13, 14, 15, 17, 19, 20 and 23 (Appendix p. 34).

The judgment of the District Court (R. 40) granted the prayer of petitioners' supplemental bill of complaint under the Declaratory Judgment Act (R. 24) and ruled that *all* claims of the Daukus patent were invalid for want of invention.

In their notice of appeal filed June 20, 1945 (R. 41), respondents appealed from "the final judgment entered in this action on June 20, 1945". Subsequently, however, respondents made a motion to amend their notice of appeal "by changing 'final judgment entered in this action on June 20, 1945' to 'that part of the final judgment entered in this action on June 20, 1945, which dismisses defendants' counterclaim'" (R. 44). The decision of the Court of Appeals was accordingly confined to those claims which respondents specified as relied on and to which they

had restricted their counterclaim.

Upon the expiration of the statutory period for appeal (three months after the entry of judgment) provided by U. S. C. Tit. 28, Sec. 230, the judgment of the District Court entered June 20, 1945, except as to that part of it dismissing their counterclaim, became final and conclusive, because respondents' appeal as completed was limited to that part of the judgment dismissing such counterclaim. See Rule 73 (a, b), Federal Rules of Civil Procedure; *American Fork & Hoe Co. v. Stampit Corp.*, (C. C. A. 6) 125 Fed. (2d) 474; *Carter v. Powell*, (C. C. A. 5) 104 F. (2) 428, 429. Since by that judgment all claims of the patent in suit were adjudged to be invalid, and under the counterclaim respondents limited their assertion of validity and infringement of claims of that patent to claims Nos. 4, 6, 13, 14, 15, 17, 19, 20, and 23, it became the duty of respondents under the disclaimer statutes (Secs. 4917, 4922, U. S. C. Tit. 35, Sec. 65, 71), *promptly* upon the expiration of the statutory period for appeal, to file a disclaimer of all claims adjudged to be invalid and not asserted under the counterclaim, namely, claims 1, 2, 3, 5, 7, 8, 9, 10, 11, 12, 16, 18, 21, and 22. *Ensten v. Simon Ascher & Co.*, 282 U. S. 445, 453; *Maytag Company v. Hurley Machine Co.*, 307 U. S. 243, 245, 246; *Marconi Co. v. U. S.*, 320 U. S. 1, 4, 58; *Otis Elevator Co. v. Pacific Finance Corp.*, (C. C. A. 9) 68 F. (2) 664, 670, 671; *Railway Engineering Co. v. Oregon Short Line Co.*, (C. C. A. 10) 79 F. (2) 469, 472; *Radio Condenser Co. v. General Instrument Corp.*, (C. C. A. 2) 65 F. (2) 458, 459; *Apex Electrical Mfg. Co. v. Maytag Co.*, 122 F. (2) 182, 188, 189. The Court of Appeals for the Sixth Circuit has held in several cases that a period of thirty days is appropriate for this purpose. *Herman v. Youngstown Car Mfg. Co.*, (C. C. A. 6) 191 Fed. 579; *Higgin Mfg. Co. v. Watson*,

(C. C. A. 6) 263 Fed. 378, 387; *Excelsior Steel Furnace Co. v. Williamson Heater Co.*, (C. C. A. 6) 269 Fed. 614, 619.

Respondents, following the decision of the District Court holding that *all claims* of the Daukus patent were invalid, found themselves on the horns of a dilemma. Had a statutory disclaimer been filed respondents, on appeal, would have been embarrassed by the requirement of establishing patentability of the subject matter of the claims on appeal over the subject matter disclaimed under the authority of this Court's decision in *Maytag Co. v. Hurley Machine Co.*, 307 U. S. 243. Respondents accordingly "elected the course which" they "would pursue with knowledge of the options open to" them. *Maytag v. Hurley Machine Co.*, *supra*. **By their failure to disclaim respondents have invalidated all claims of their patent.**

As the Court said in the *Marconi case*, 320 U. S. 58:

"The purpose of the rule that a patent is invalid in its entirety if any part of it be invalid is the protection of the public from the threat of an invalid patent, and the purpose of the disclaimer statute is to enable the patentee to relieve himself from the consequences of an invalid claim if he is able to show both that the invalid claim was inadvertent and that the disclaimer was made without unreasonable neglect or delay. . . . Here the patentee has sustained neither burden."

Respondents deliberate, "unreasonable neglect or delay to enter a disclaimer" as required by the disclaimer statutes, invalidates the entire patent in suit. The propriety of presenting the point to this Court, and the manner in which petitioners presented it are indicated in several cases. *Electrical Fittings Corp. v. Thomas & Betts Co.*, 307 U. S. 241, 242; *Muncie Gear Works v. Outboard M. & Mfg. Co.*, 315 U. S. 759, 768; *U. S. v. Alaska S. S. Co.*,

253 U. S. 113; *U. S. v. Anchor Coal Company*, 279 U. S. 971, 972; *County of Dakota v. Glidden*, 113 U. S. 222, 225, 226; the *American Wood Paper Co. v. Heft*, 75 U. S. 333; 19 L. Ed. 378, 379; *Lord v. Veazie*, 8 How. 251. In the *Electrical Fittings* case, which involved the right of a successful defendant in a patent infringement suit to have a decree that a patent claim was valid but not infringed, reformed to eliminate the adjudication of validity, the Court said (p. 242) :

“We think the petitioners were entitled to have this portion of the decree eliminated, and that the Circuit Court of Appeals had jurisdiction, as we have held this Court has, to entertain the appeal, not for the purpose of passing on the merits, but to direct the reformation of the decree.”

This Court in *Muncie Gear Works v. Outboard, M. & Mfg. Co.*, 315 U. S. 759, decided March 30, 1942, granted certiorari because of the concentration of industry in the Seventh Circuit. One of the questions involved was the failure of the patentee to present claims within two years from the date of a public use or sale of the invention under Section 4886 of the Revised Statutes. The question had not been clearly presented to the Circuit Court of Appeals “if indeed it was presented at all”. But this Court nevertheless accepted jurisdiction over the question, stating (p. 768) :

“* * * We are not foreclosed from a decision under §4886 on the point by the obscurity of its presentation in the courts below. This issue has been fully presented to this Court by the petition for a writ of certiorari, and in subsequent briefs and argument; and there is not the slightest indication that respondents have been prejudiced by such obscurity. To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the pat-

ent statutes, and so frequently present but so seldom adequately represented in patent litigation."

In *Sundstrand v. Gubelmann*, 4 F. (2) 166, the Court of Appeals for the District of Columbia, on a question which involved the failure to copy claims of a patent within two years, held that notwithstanding the fact that the issue had not been raised below, that it was jurisdictional in nature and could be raised at any time.

See, also, *O'Brien v. Bonelli*, 18 F. (2) 190, by the Court of Appeals for the District of Columbia.

It seems clear that the Court ought not to permit the judgment of the Court of Appeals in this case to stand without review.

Respectfully submitted,

MAX W. ZABEL,

EDWARD C. GRITZBAUGH,

BENTON BAKER,

Counsel for Petitioners.

I, Edward C. Gritzbaugh, counsel for the above named petitioners, do hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for delay.

EDWARD C. GRITZBAUGH,

Counsel for Petitioners.

A P P E N D I X .**I.**

Affidavit of Oscar P. Pearson, Statistician of the Automobile Manufacturers Association.

(Caption Omitted)

STATE OF MICHIGAN } ss.
COUNTY OF WAYNE }

OSCAR P. PEARSON, being duly sworn, deposes and says that he is the Statistician of the Automobile Manufacturers Association, Inc., a non-profit corporation, organized and existing under the Membership Corporations Law of the State of New York; that the Association has its headquarters in Detroit, Michigan; that the membership of that Association comprises all of the principal manufacturers of motor vehicles in the United States except the Ford Motor Company; that all of the members of the said Association make regular reports to the Association of the number of their factory sales of automotive vehicles produced by them; that the said Association has received statistical data of the factory sales of motor vehicles of the automotive industry in the United States, including the sales of members and non-members of the Association; that the said records include the number of the factory sales of motor vehicles manufactured, if any, by the manufacturers listed in Exhibit A hereto attached; that such list includes all the motor vehicle manufacturers now producing motor vehicles in the United States; that he has been in charge of the supervision and keeping of such records for the past twenty-five years and in such capacity is fully informed thereof; that he has computed from the information contained in such records the total number of

all of the factory sales of motor vehicles made by all of the manufacturers listed in Exhibit A including both members of the Association and non-members; that he finds that more than ninety-five percent of the total of all of the factory sales of motor vehicles manufactured in the United States during the eleven months ending November 30, 1946 were made by companies having established places of business in the States of Michigan and Ohio where they manufactured or sold motor vehicles; that the records of factory sales for said eleven months show that 2,713,421 motor vehicles were sold by the manufacturers having established places of business in the States of Michigan and Ohio where vehicles were made or sold; that only 127,838 motor vehicles were manufactured or sold in the United States during the same period by manufacturers having no established place of business in Michigan or Ohio; and that the proportion of the factory sales of motor vehicles made by the same companies in the preceding ten years is also substantially the same proportion of the entire factory sales of the automotive industry of the United States as for the time stated above.

Oscar P. Pearson

Subscribed and sworn to before me, a Notary Public,
this 28th day of January, 1947.

Muriel J. Willoughby,
Notary Public

(Seal)

My Commission Expires May 28, 1948.

EXHIBIT "A".

(To be attached to affidavit signed by Oscar P. Pearson, Jan. 28, 1947.)

**MOTOR VEHICLE MANUFACTURERS IN
THE UNITED STATES**

ACF-Brill Motors Company	Ford Motor Company
Philadelphia 42, Pennsylvania	Dearborn, Michigan
The Autocar Company	The Four Wheel Drive Auto Co.
Ardmore, Pennsylvania	Clintonville, Wisconsin
Available Truck Company	General American Aerocoach Co.
Chicago, Illinois	Chicago, Illinois
Beaver Metropolitan Coaches, Inc.	General Motors Corporation
Beaver Falls, Pennsylvania	Detroit 2, Michigan
C. D. Beck Company	Gotfredson Truck Company
Sidney, Ohio	Detroit 7, Michigan
Biederman Motors Corporation	Graham-Paige Motors Corporation
Cincinnati 14, Ohio.	Willow Run, Michigan
Brockway Motor Company, Inc.	Hahn Motors, Inc.
Cortland, New York	Hamburg, Pennsylvania
Brown Equipment Company	Hendrickson Motor Truck Co.
Charlotte, North Carolina	Chicago 15, Illinois
Checker Cab Mfg. Corp.	Hudson Motor Car Company
Kalamazoo 13, Michigan	Detroit 14, Michigan
Chrysler Corporation	The Hug Company
Detroit 31, Michigan	Highland, Illinois
Coleman Motors Corp.	International Harvester Company
Littleton, Colorado	Chicago 1, Illinois
The Corbitt Company	Kaiser-Frazer Corporation
Henderson, North Carolina	Willow Run, Michigan
Crosley Motors, Inc.	Kalamazoo Coaches, Inc.
Cincinnati 14, Ohio	Kalamazoo, Michigan
Crown Body & Coach Company	Kenworth Motor Truck Corp.
Los Angeles, California	Seattle 11, Washington
Dart Truck Company	MacDonald Truck & Mfg. Co.
Kansas City 8, Missouri	San Francisco, California
DeMartini Motor Truck Co.	Mack Manufacturing Corporation
San Francisco, California	New York 1, New York
Diamond T Motor Truck Company	Marmon-Herrington Co., Inc.
Chicago 23, Illinois	Indianapolis 7, Indiana
Divco Corporation	Nash Motors Division
Detroit 5, Michigan	Nash-Kelvinator Corporation
Duplex Truck Company	Detroit, Michigan
Lansing 4, Michigan	Oshkosh Motor Truck, Inc.
Federal Motor Truck Company	Oshkosh, Wisconsin
Detroit 9, Michigan	Packard Motor Car Company
Fitzjohn Coach Company	Detroit 32, Michigan
Muskegon 89, Michigan	Peterbilt Motors, Inc.
The Flexible Company	Oakland, California
Loudonville, Ohio	Reo Motors, Inc.
	Lansing 20, Michigan

Southern Coach & Body Company
Evergreen, Alabama
Sterling Motor Truck Company
Milwaukee 1, Wisconsin
Stewart Motor Corporation
Buffalo, New York
The Studebaker Corporation
South Bend 27, Indiana
Superior Coach Company
Lima, Ohio
Transit Buses, Inc.
Dearborn, Michigan

Twin Coach Company
Kent, Ohio
Walter Motor Truck Company
Ridgewood, L. I., 27, New York
Ward LaFrance Truck Division
Great American Industries
Elmira, New York
The White Motor Company
Cleveland 1, Ohio
Willys-Overland Motors, Inc.
Toledo 1, Ohio

II.

Affidavit of Tolbert L. Knecht, Vice-President and General Manager of Borg and Beck Division of Borg-Warner Corp.

(Caption Omitted)

STATE OF ILLINOIS }
COUNTY OF COOK } ss.

TOLBERT L. KNECHT, being duly sworn, deposes and says that he is Vice-President and General Manager of the Borg and Beck Division of Borg-Warner Corporation, one of the appellees in litigation now pending in the United States Court of Appeals for the Sixth Circuit, entitled George I. Goodwin and John F. Daukus, Appellants, *vs.* Borg-Warner Corporation and David E. Gamble, Appellees; that the said Borg and Beck Division formerly was known as Borg and Beck Company; that he has been engaged in and familiar with the manufacture, sale, distribution, and installation of clutches and friction clutch plates for use in automotive vehicles and particularly the business of said Borg and Beck Division and the said Borg and Beck Company and the practices of their customers pertaining to the installation and assembly of clutches and clutch plates in automotive vehicles continuously since the year 1920; that the said Borg and Beck Division is one of the larger manufacturers of clutches and clutch plates in the

United States; that the Borglite plate manufactured by the said Borg and Beck Division and in said litigation charged to infringe United States Letters Patent No. 2,324,913 is now employed as the standard driven clutch plate in automotive vehicles manufactured by the following twelve leading companies:

Chrysler Corporation, Detroit, Michigan

Chrysler automobiles

De Soto automobiles

Plymouth automobiles

Dodge automobiles

General Motors Corporation, Detroit, Michigan

Buick automobiles

Cadillac automobiles

Chevrolet automobiles

Oldsmobile automobiles

Plymouth automobiles

Studebaker Corporation, South Bend, Indiana

Nash Motors, Division of Nash Kelvinator Corporation, Kenosha, Wisconsin

Willys-Overland Motors, Inc., Toledo, Ohio

Kaiser-Frazer Motors, Inc., Detroit, Michigan;

that the Chevrolet Division of General Motors Corporation is manufacturing the said Borglite design of clutch plate in its own plants in the State of Michigan in excess of two hundred thousand clutch plates per year; that he is informed and in a position qualifying him to estimate the quantity of driven clutch plates produced commercially in the United States for installation in automotive vehicles and the places where they are manufactured and installed; that in the opinion of the affiant more than ninety-five per cent (95%) of all of the driven clutch plates manufactured in the United States for assembly as original equipment in automotive vehicles in the United States are either manufactured by manufacturers located within the States of Michigan and Ohio or manufactured by the said Borg-

Warner Corporation, or assembled in automobile engine assemblies in the States of Michigan and Ohio.

Tolbert L. Knecht

Subscribed and sworn to before me this 29th day of January, 1947.

O. JANES,

(Seal)

Notary Public

III.

Affidavit of G. Carroll Buzby, President of Automotive Division of the Chilton Company.

(Caption Omitted)

STATE OF PENNSYLVANIA } ss.
COUNTY OF PHILADELPHIA }

G. CARROLL BUZBY, being duly sworn deposes and says that he is President of the Automotive Division of the Chilton Company which publishes the publications known as "Automotive and Aviation Industry", "Commercial Car Journal", "Motor Age", and Chilton Automotive Buyers Guide"; that the said Company engages in the compilation and publication of statistics derived from original sources pertaining to the production of automotive vehicles throughout the United States; that these statistics include among other things the production of automotive vehicles in the United States and the location of the various manufacturers thereof; that affiant is informed of the said statistics and in a position qualifying him to state the quantity of automotive vehicles manufactured in the United States and where they are manufactured; that in the opinion of affiant more than ninety-five per cent of the automotive vehicles manufactured in the United States are manufactured by manufacturers located or hav-

ing a regular and established place of business within, incorporated in, or admitted to do business and subject to suit in, the States of Michigan atnd Ohio.

G. Carroll Buzby

Subscribed and sworn to before me, a Notary Public, this 24th day of January, 1947.

Philip J. Shire, Jr.

Notary Public

Notary Public

My Commission Expires at the End
of the Next Session of the Senate

(Seal)

IV.

Affidavit of Max W. Zabel.

(Caption Omitted)

STATE OF ILLINOIS }
COUNTY OF COOK } ss.

MAX W. ZABEL, being duly sworn, deposes and says that he is one of the attorneys for plaintiff, appellee in the cause identified as George I. Goodwin and John F. Daukus, Appellants, *vs.* Borg-Warner Corporation and David E. Gamble, Appellees, No. 10,119 pending in the United States Circuit Court of Appeals for the Sixth Circuit;

That he appeared as one of the attorneys for the said Borg-Warner Corporation and David E. Gamble, plaintiffs in the said action, at the trial thereof before Honorable Arthur F. Lederle, District Judge, in the District Court of the United States for the Eastern District of Michigan, Southern Division, at Detroit, Michigan, beginning on Thursday, June 1, 1944, at ten o'clock A. M., continuing on the following day and again on Tuesday September 26, 1944, beginning at ten o'clock A. M., on which

day the trial was concluded, and participated in and was present throughout the trial proceedings in that Court; that Raymond L. Greist, Esq., appeared as attorney for the said George I. Goodwin and John F. Daukus, defendants, participated in and was present at the said trial throughout its duration; that during the course of the said trial statements were made in the presence of affiant by the Court and the said Raymond L. Greist as attorney for the said George I. Goodwin and John F. Daukus, which statements appear in an official transcript of the proceedings at the said trial, as follows:

Mr. Greist (June 1, 1944), Transcript p. 107:—

“If you will refer to what I call my trial brief, I would like to say why the majority of the claims of the Daukus patent in suit are in our opinion both valid and infringed. We choose to rely, for the purpose of infringement, on the following claims: I have noted this on my copy of the Daukus patent; they are claims 4, 6, 13, 14, 15, 17, 19, 20, and 23.”

Excerpts from Transcript for Tuesday, September 26, 1944:—

(p. 55) “The Court: Mr. Greist, what Mr. Zabel was just saying to me is that if your patent is sustained, the device that I have here—this is Exhibit AAA-30—and this reads right on your patent, that Borg-Warner is manufacturing a device that they manufactured millions of back in the late 20's, they would now be infringing your patent, and that, in effect, you could start collecting royalties on this old device he stated they manufactured back in 1928. . . .”

(p. 56) “Mr. Greist: Anything that would, coming later, be an infringement, would, if it came before, be an anticipation. And I agree with that 100 per cent . . .”

(p. 58) (continuing) “Now, I say this, that while our patent contains a number of claims, we are relying only on certain of them. I am not prepared to say that a few of the claims of this Daukus patent clearly define what we now find to be the patentable invention

over the prior art. We could not have disclaimed before, because we did not know."

(p. 81, 82) "The Court: . . . Where does it leave you if you were in a position where you had to concede that some of your claims in the Daukus patent were too broad?"

Mr. Greist: We are not required to disclaim until such time as we know they are too broad or until such time as the Court has told us so. We can disclaim within 30 days after you say, for instance, that claims 1 and 2 are too broad. We could disclaim right now if we can thereby reach an issue.

I say this, that our claims which do not bring in the fact that our cushion members are both distorted axially and are structurally independent members between the facings, if the claims do not bring that in, I do not believe they define invention."

that he appeared as attorney for the said Borg-Warner Corporation and David E. Gamble, appellees, and argued the said cause for them before the United States Circuit Court of Appeals for the Sixth Circuit comprising Circuit Judges Simons, Allen, and Martin, at Cincinnati, Ohio, on April 11, 1946, and at which time and place the said Raymond L. Greist, Esq., appeared and argued the cause for the said George I. Goodwin and John F. Daukus, appellants, and was provided with a copy of the appellants' brief filed with and submitted to that Court by the said Raymond L. Greist, Esq. as their attorney; that in accordance with sub-division 2 of Rule 21 of that Court, there is set forth on the unnumbered flyleaf of the said appellants' brief in that Court the following:

"STATEMENT OF QUESTIONS INVOLVED

1. *Did Daukus' contribution to the clutch plate art amount to patentable invention in view of the state of the art at the time he made the invention?*

The District Judge found that it did not amount to patentable invention.

The District Judge should have found that it did.

2. *Is Borg-Warner Corporation's "Borglite" clutch plate an infringement of any of the claims of the Daukus patent?*

The District Judge, having found the patent invalid in its entirety, did not pass on this.

The District Judge should have found claims 4, 6, 13, 14, 15, 17, 19, 20, and 23 of the patent valid and infringed by the "Borglite" plate."

On the first page of appellants' brief it is stated:

"This is an appeal from the judgment of the District Court in dismissing defendants' patent infringement counterclaim, in which counterclaim defendants had asked that the Court find Daukus patent No. 2,324,913 valid and infringed."

On the second page of appellants' brief it is stated:

"THE JUDGMENT

"The District Court dismissed the original complaint, held the Daukus patent invalid and dismissed the counterclaim (Rec. 40). Plaintiffs did not appeal. Defendants have appealed from that part of the judgment which dismissed the counterclaim (Rec. 44).

On pages 16 and 17 of appellants' brief it is stated:

"The District Judge was advised at the time of the trial that on the issue of patent infringement defendants were relying on claims 4, 6, 13, 14, 15, 17, 19, 20, and 23 as infringed."

that the argument contained in the appellants' brief is devoted to two topics which are stated in the language of the two questions set forth in the "Statement of Questions Involved" on the flyleaf thereof, above quoted, and under the second of these topics, on p. 37 it is stated:

"Of the nine claims which are asserted here as infringed, namely, claims 4, 6, 13, 14, 15, 17, 19, 20, and 23, . . .";

that appellants did not assert in said brief or in the argu-

ment before the said Circuit Court of Appeals either validity or infringement of any claims of the said Daukus Patent No. 2,324,913 except those specified in their brief as hereinbefore stated; that on the 14th day of January, 1947, he caused an investigation to be made of the records in the United States Patent Office, in the City of Washington, in the District of Columbia, wherein the filing of disclaimers of United States Letters Patent for inventions is recorded for the purpose of ascertaining whether or not any disclaimer of claims of United States Letters Patent No. 2,324,913 issued to John F. Daukus for Clutch Plate had been filed in that office, and that no record of any such disclaimer was found.

Max W. Zabel

Subscribed and sworn to before me, a Notary Public, this 25th day of January, 1947.

Janet E. Irwin

Notary Public

(Seal)

V.

DEPARTMENT OF COMMERCE

United States Patent Office

To all persons to whom these presents shall come,

Greeting:

This is to Certify that the annexed is a true copy from the records of this office of Letter of the Executive Officer, dated January 17, 1947, and addressed to:—

Bacon & Thomas
Attorney at Law
Shoreham Building
Washington 5, D. C.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this seventeenth day of January, in the year of our Lord one thousand nine hundred and forty-seven and of the Independence of the United States of America the one hundred and seventy-first.

Casper W. Ooms,

Commissioner of Patents.

Attest:

D. E. Wilson,

Chief of Division.

(Seal)

DEPARTMENT OF COMMERCE

United States Patent Office

Washington

R

January 17, 1947.

Bacon & Thomas
Attorneys at Law
Shoreham Building
Washington 5, D. C.
Gentlemen:

This will acknowledge your letter of January 14, 1947.

The records of the Patent Office fail to show that any statutory disclaimer has been filed in connection with Dankus patent 2,324,913.

Very truly yours,
C. E. Haglund
C. E. Haglund
Executive Officer